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10/666,388	09/19/2003	Marc M. Gibeley	86880THC	7524

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EXAMINER

JERABEK, KELLY L

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2622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/666,388	Applicant(s) GIBELEY ET AL.	
	Examiner Kelly L. Jerabek	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/12/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

New Examiner of Record

The prosecution of this application has been transferred to Examiner Kelly Jerabek from the docket of Examiner Gary Vieaux. Any inquiry concerning this Office Action or earlier communications should be directed to the current Examiner of record. Current contact information is provided in the last section of this communication.

Response to Arguments

Applicant's arguments with respect to claims 1-5 and 7-40 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 30 is rejected under 35 U.S.C. 102(a) as being anticipated by Kubota US 2003/0001957.

Re claim 30, Kubota discloses a method of providing photofinishing services, comprising the steps of: a photographer providing a digital camera (120); supplying to the photographer at least one removable memory device (122) selected from a variety of available formats and having a format appropriate for use in the digital camera (120) provided by the photographer (figure 8; page 6, paragraph 119); the photographer photographing, downloading or transferring from other electronic devices, a plurality of digital images for storage on the at least one removable memory device (page 2, paragraph 51); the photographer delivering the at least one removable memory device (122) containing the digital images to a photofinisher (130) (page 6, paragraph 121); the photofinisher (130) producing prints of the digital images and returning the prints to the photographer (page 6, paragraphs 122-123); and the photofinisher (130) erasing the digital images from the at least one removable memory device (122) and preparing the at least one memory device (122) to be supplied to another photographer to repeat the steps above (page 6, paragraphs 124-128).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870.

Re claim 1, Kubota discloses a method of providing photofinishing services, comprising the steps of: supplying to a photographer at least one removable memory device (122) selected from a variety of available formats and having a format appropriate for use in the digital camera (120) provided by the photographer (figure 8; page 6, paragraph 119); the photographer photographing, downloading or transferring from other electronic devices, a plurality of digital images for storage on the at least one removable memory device (page 2, paragraph 51); the photographer delivering the at least one removable memory device (122) containing the digital images to a photofinisher (130) (page 6, paragraph 121); the photofinisher (130) producing prints of the digital images and returning the prints to the photographer (page 6, paragraphs 122-123); and the photofinisher (130) erasing the digital images from the at least one removable memory device (122) and preparing the at least one memory device (122) to be supplied to another photographer to repeat the steps above (page 6, paragraphs 124-128). However, although the Kubota reference discloses all of the above limitations it fails to state that the photographer may optionally delete some or all of the digital images on the removable memory device.

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Nanba discloses a digital photographing apparatus. Nanba states that the digital camera includes a delete key (D) for deleting the images recorded in a memory card (8) (col. 3, lines 33-49). Therefore, it would have been obvious for one skilled in the art to have been motivated to include an optional deleting function allowing a user to delete images stored on a memory card of a digital camera as disclosed by Nanba in the digital camera of the system disclosed by Kubota. Doing so would provide a means for allowing a user to capture images and delete the images that the user does not want in order to free up memory space on the removable memory.

Re claim 7, Kubota states that the removable memory device (122) comprises a compact flash (CF) format (page 6, paragraph 130).

Claims 2 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 and further in view of Takano US 2001/0041072.

Re claim 2, the combination of the Kubota and Nanba references discloses all of the limitations of claim 1 above. However, neither reference states that the photofinisher produces index print and/or CD of the digital images from the memory device and returns the index print and/or CD to the photographer. However, Kubota does state that the images may be printed out by the photofinisher.

Nevertheless, Takano discloses producing and providing an index print to a digital image customer (figure 18; pages 5-6 paragraphs 83-84). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a print index as taught by Takano with the method as taught by the combination of Kubota and Nanba so that the customer may take the physical print index with them, so that they do not have to immediately decide with prints to purchase upon submission of the memory device.

Re claim 28, the combination of the Kubota and Nanba references discloses all of the limitations of claim 1 above. However, neither reference states that the photofinisher produces index print and/or CD of the digital images from the memory device and returns the index print and/or CD to the photographer, wherein the index print includes a printed filename of a corresponding image file recorded on the CD. However, Kubota does state that the images may be printed out by the photofinisher.

Nevertheless, Takano discloses producing and providing an index print to a digital image customer in which the image is assigned a number corresponding to the digital image (figure 2 indicator 76, figure 18 indicator 706; pages 5-6 paragraphs 83-84), as well as producing a CD on which the corresponding digital images are stored (figure 5, indicator 24 and 63; page 7, paragraph 101). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a print index and CD, with corresponding image labels/names as taught by Takano with the method as taught by Okada so that a customer may take the physical print index with them so that

they do not have to immediately decide which prints to purchase upon submission of the memory device, and so that they are not required to use a computer or other device to view potential images, as well as providing a logical method of using the CD to make later print selections by way of matching image numbering convention.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 further in view of Takano US 2001/0041072 and further in view of Parulski et al. US 2003/0025808.

Re claim 3, the combination of the Kubota, Nanba and Takano references discloses all of the limitations of claim 2 above. Additionally, Takano discloses providing an index print to a digital image customer in which the image is assigned a number corresponding to the digital image (figure 2 indicator 76, figure 18 indicator 706; pages 5-6 paragraphs 83-84), as well as producing a CD on which the corresponding digital images are stored (figure 5, indicator 24 and 63; page 7, paragraph 101). However, the combination fails to disclose that the removable memory device contains N digital images and also indicates that M prints have been promised, where M is less than N.

Parulski discloses a digital camera that includes a user interface that allows a camera user to create a print order "utilization file". Parulski states that using the camera user interface the user can select desired downstream services such as printing images selected by the user in order to create a utilization file that is subsequently

stored on a memory card (36) (page 2, paragraph 17). Therefore, it would have been obvious for one skilled in the art to have been motivated to store a utilization file including a print order for images selected by a user as disclosed by Parulski in the removable memory device of the photofinishing system disclosed by the combination of Kubota, Nanba and Takano. Doing so would provide a means for allowing a user to designate a certain number of captured images to be printed out.

Re claim 4, Takano discloses an index print and/or a CD containing all N of the digital images on the memory device and indicates which images have or have not been printed (figure 18; page 4, paragraph 67; pages 5-6, paragraphs 82-84, in which a completed and fulfilled index print would inherently contain the images and indicate the images that had been printed).

Re claim 5, Takano discloses that the index print and/or the CD contain instructions for obtaining prints of the unprinted images (page 4, paragraph 67; page 5, paragraph 82).

Claims 8-9, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 and further in view of Reifel et al. US 7,013,288.

Re claim 8, the combination of the Kubota and Nanba references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that the memory device bears a code that indicates to the photofinisher that the memory device carries with it the commitment to create prints.

Nevertheless, Reifel discloses a consumer being supplied with a similar memory device that bears a code that indicates to the photofinisher that the memory device carries with it the commitment to create prints (fig. 9; col. 4 lines 20-23.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include a code as taught by Reifel with the memory device of the method as taught by the combination of Kubota and Nanba in order to visually indicate that the commitment has been entered into and the extent of the commitment, e.g. the number of prints to create.

Re claim 9, the combination of the Kubota and Nanba references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that the memory device bears a graphic that indicates that the card carries with it the commitment to create prints.

Nevertheless, Reifel discloses a consumer being supplied with a similar memory device that bears a graphic that indicates that the memory device carries with it the commitment to create prints (fig. 9; col. 4 lines 20-23.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include a graphic as taught by Reifel with the memory device of the method as taught by the combination of Kubota

and Nanba in order to visually indicate that the commitment has been entered into and the extent of the commitment, e.g. the number of prints to create.

Re claim 24, the combination of the Kubota and Nanba references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that the memory device includes a prerecorded image.

Nevertheless, Reifel discloses a consumer being supplied with a similar memory device that displays prerecorded image (col. 10 lines 9-48.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include a prerecorded image, such as an advertisement, in order to generate additional revenue for the Photofinisher or reduce the device cost for the consumer.

Re claim 26, Reifel further discloses a step of selling advertising space in the prerecorded image (col. 9 line 52 – col. 10 line 48.)

Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 further in view of Reifel et al. US 7,013,288 and further in view of Examiner's Official Notice.

Re claim 10, the combination of the Kubota and Nanba references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that the

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memory device is returned with less than a predefined number of image files, and including the step of providing a credit to the photographer.

Reifel discloses a consumer being supplied with a similar memory device in which a contract for photofinishing services is entered into in exchange for a reduced price of the memory device (col. 4 lines 20-23.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include an agreement for photofinishing services as taught by Reifel with the method as taught by the combination of Kubota and Nanba as a way to secure additional business or extend a business relationship.

Further, Official Notice is taken regarding the well-known practice of prepayment for goods or services and then providing a credit for unused goods or services previously purchased. It would have been obvious to one of ordinary skill in the art at the time of the invention for a user to prepay for images to be printed from the memory device and method taught by Kubota, Nanba and Reifel, as a way to provide advanced notice to the photofinisher that a certain number of images will potentially be ordered, thereby assisting in the prediction of available cash flow and more accurate bookkeeping, and then to further provide a credit for the unused image amounts so that the user is fairly charged for the only prints produced, and so that a more equitable business arrangement would also be created.

Re claim 11, the combination of the Kubota and Nanba references discloses all of the limitations of claim 10 above. However, the combination fails to disclose that the credit is in the form of a coupon.

Nevertheless, Official Notice is also taken regarding the well-known practice of providing a coupon as a form of credit, such as a store credit receipt. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the credit in the form of a coupon in order to prevent the credit from being applied elsewhere, and therefore assisting in retaining business profits previously predicted and accounted.

Re claim 12, the combination of the Kubota and Nanba references discloses all of the limitations of claim 10 above. However, the combination fails to disclose that the credit is in the form of a debit card that is returned with the prints.

Nevertheless, Official Notice is also taken regarding the well-known practice of providing a debit card as a form of credit. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the credit in the form of a debit card in order to prevent the credit from being applied elsewhere, and therefore assisting in retaining business profits previously predicted and accounted.

Further, Official Notice is also taken regarding the well-known practice of not returning a credit until after a full accounting of the good or services have been rendered. It would have been obvious to one of ordinary skill in the art at the time of the

invention to wait to provide the credit until the prints are produced for the end user so that an accurate accounting of the amount to be credited can be determined.

Re claim 13, the combination of the Kubota and Nanba references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that a debit card for photofinishing services is supplied to the photographer along with the memory device and the debit card is presented to the photofinisher along with the memory device.

Reifel discloses a consumer being supplied with a similar memory device in which a contract for photofinishing services is entered into in exchange for a reduced price of the memory device (col. 4 lines 20-23.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include an agreement for photofinishing services as taught by Reifel with the method as taught by Kubota and Nanba as a way to secure additional business or extend a business relationship.

Further, Official Notice is taken regarding the well-known practice of providing a debit card, associated with a bank or a financial institution, to a provider of goods or services in order to provide authorization for payment, and then later providing the debit card again to provide payment for the goods or services once rendered, such as for the prior authorization and then payment of a hotel stay by way of a debit card. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ a debit card in an analogous manner in which a debit card would be presented to the photofinisher for authorization for photofinishing services, and then given back to

the user along with the memory device, and then presented again along with the memory device when the photofinishing services were to actually be provided, and in doing so, fulfilling the quid pro quo arrangement of money for goods and services.

Claims 14-15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 and further in view of Robins et al. US 2003/0151669.

Re claim 14, the combination of Kubota and Nanba discloses all of the limitations of claim 1 above. However, the combination fails to specifically state that the removable memory device includes a first portion of memory that is electronically readable by a supplier and the photofinisher but not by the digital camera provided by the photographer, and a second portion of memory that is electronically readable by the supplier, the photofinisher, and the digital camera provided by the photographer.

Robins discloses a digital camera that has a remote enable/disable capability. The camera disclosed by Robins includes a removable memory card (134) that includes a first portion of memory (212,216,221) that is electronically readable by a supplier (rental entity) but not by the digital camera provided by the photographer, and a second portion of memory (223) that is electronically readable by the supplier and the digital camera provided by the photographer (figure 2; page 2, paragraphs 26-30). Therefore, it would have been obvious for one skilled in the art to have been motivated to include the memory including a memory area that is only controllable by the supplier as

disclosed by Robins and the photofinishing system disclosed by the combination of Kubota and Nanba. Doing so would provide a means for allowing a distributor of the memory card to track the memory card and to control the use of the memory card by a user.

Re claim 15, Robins further states that the first portion (221) of memory contains a unique ID (serial number or other identifier) (figure 2; page 2, paragraph 30).

Re claim 27, the combination of Kubota and Nanba discloses all of the limitations of claim 1 above. However, the combination fails to specifically state that the removable memory device includes a code in a file hidden from electronic access by the photographer or in a pseudo bad sector of its memory that is inaccessible electronically by the photographer that indicates to the photofinisher that the at least one removable memory device carries with it a commitment to create prints.

Robins discloses a digital camera that has a remote enable/disable capability. The camera disclosed by Robins includes a removable memory card (134) that includes a first portion of memory (212) that includes a code in a file hidden from electronic access by the photographer or in a pseudo bad sector of its memory that is inaccessible electronically by the photographer that indicates to the photofinisher that the at least one removable memory device carries with it a commitment to create prints (figure 2; page 2, paragraphs 26-30). Therefore, it would have been obvious for one skilled in the art to have been motivated to include the memory including a memory area that is only

controllable by the supplier as disclosed by Robins and the photofinishing system disclosed by the combination of Kubota and Nanba. Doing so would provide a means for allowing a distributor of the memory card to track the memory card and to control the use of the memory card by a user.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 further in view of Robins et al. US 2003/0151669 and further in view of Yamashina et al. JP 05-093950.

Re claim 16, the combination of the Kubota, Nanba and Robins references discloses all of the limitations of claim 14 above. However, the combination fails to specifically state that the protected memory area contains a number indicating the number of times that the memory device has been recycled.

Nevertheless, Yamashina discloses indicating the number of times a camera component has been recycled (Abstract.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include the number of times the memory device has been recycled within the protected memory area as taught by Yamashina with the method as taught by the combination of Kubota, Nanba and Robins in order to help maintain a stable level of quality.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 further in view of Robins et al. US 2003/0151669 and further in view of Okada et al. US 2001/0040625.

Re claim 17, the combination of the Kubota, Nanba and Robins references discloses all of the limitations of claim 14 above. However, the combination fails to specifically state that the first portion of memory contains instructions for the photofinisher provided by the supplier.

Okada discloses a digital camera capable of being collected for reuse. Okada discloses a memory area that contains instructions for the photofinisher provided by the supplier (page 5, paragraph 86 and page 4, paragraph 63, which includes providing information to correspond the image data with a particular homepage address). Therefore, it would have been obvious for one skilled in the art to have been motivated to store instructions for the photofinisher as disclosed by Okada in the first portion of the memory disclosed by the combination of the Kubota, Nanba and Robins references. Doing so would provide a means for effectively identifying images and easily producing a print of an image.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 further in view of Reifel et al. US 7,013,288 and further in view of Okada.

Re claim 25, the combination of the Kubota, Nanba and Reifel references discloses all of the limitations of claim 24 above. However, the combination fails to specifically state that the prerecorded image contains instructions to the photographer for using the photofinishing services.

Okada discloses a digital camera capable of being collected for reuse. Okada discloses a memory area that contains instructions to the photographer for using the photofinishing services (page 5, paragraph 86 and page 4, paragraph 63, figure 1A and 1B which includes providing information to correspond the image data with a particular homepage address). Therefore, it would have been obvious for one skilled in the art to have been motivated to store instructions for the photofinisher as disclosed by Okada in the first portion of the memory disclosed by the combination of the Kubota, Nanba and Robins references. Doing so would provide a means for effectively identifying images and easily producing a print of an image.

Claims 18-19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 and further in view of Examiner's Official Notice.

Re claim 18, the combination of the Kubota and Nanba references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that the method further comprises the steps of supplying a claim card for retrieving photofinishing services to the photographer along with the memory device and

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presenting the claim card to the photofinisher to retrieve the photofinishing order.

However, Kubota does disclose that the external storage medium (122) can be identified therefore there is an inherent external storage medium password or identifier (page 6, paragraphs 128-130).

Nevertheless, Official Notice is taken regarding the well-known practice of providing a claim card to an individual who is transferring control of an item, in order to associate an individual with an item, and then that individual presenting the card in order to reclaim control of that item at a later point in time, similar to the method employed in the dry cleaning industry or with valet parking. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ a claim card in an analogous manner with the method as taught by the combination of the Kubota and Nanba references in order to associate the memory device and the corresponding order with the user in an analogous manner.

Re claim 19, the combination of the Kubota and Nanba references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that the method further comprises the steps of supplying a removable tag for retrieving photofinishing services to the photographer along with the memory device and presenting the removable tag to the photofinisher to retrieve the photofinishing order. However, Kubota does disclose that the external storage medium (122) can be identified therefore there is an inherent external storage medium password or identifier (page 6, paragraphs 128-130).

Nevertheless, Official Notice is taken regarding the well-known practice of providing a removable tag to an individual who is transferring control of an item, in order to associate that individual with an item, and then that individual presenting the tag in order to reclaim control of that item, similar to the method employed in the dry cleaning industry or with valet parking. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ a removable tag with the method as taught by Kubota in view of Nanba in order to associate the memory device and the corresponding order with the user in an analogous manner.

Re claim 23, the combination of the Kubota and Nanba references discloses all of the limitations of claim 1 above. However, the combination fails state that the step of erasing the digital images from the memory device includes writing a test pattern onto the memory device.

Official Notice is taken regarding the well-known practice of writing a test pattern onto a memory device in order to verify its functionality; a concept that is well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to include writing a test pattern onto the memory device as not only a way to verify its functionality, but also as a tool to effectively erase the digital images from the memory device by overwriting them with the test pattern.

Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 and further in view of Okada et al. US 2001/0040625.

Re claim 20, the combination of the Kubota and Nanba references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that the method further comprises the step of writing an identifier unique to the photographer on the at least one removable memory device and presenting the identifier unique to the photographer to the photofinisher to retrieve the photofinishing services. However, Kubota does disclose that the external storage medium (122) can be identified therefore there is an inherent external storage medium password or identifier (page 6, paragraphs 128-130).

Okada discloses a digital camera system including a digital camera capable of being collected for reuse. The camera (10) disclosed by Okada stores photographed image data (73a) and an identification code (73b) for identifying an individual camera (10). The system also includes a memory card (74) that stores a URL and a password (74a) for obtaining photographed data (page 6, paragraph 101). Okada further states that a user may give their email address to the selling store in order to receive the password and URL by email (page 6, paragraphs 110-11). Therefore, it would have been obvious for one skilled in the art to have been motivated to write an identifier unique to the photographer as disclosed by Okada in the memory disclosed by the combination of the Kubota and Nanba references and present the identifier in order to

retrieve photofinishing services. Doing so would provide a means for effectively identifying a photographer and allowing a photofinisher to easily produce a print of an image and distribute it to the photographer.

Re claim 21, the combination of the Kubota and Nanba references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that the method further comprises the step of writing a phone number or e-mail address of the photographer on the at least one removable memory device and presenting the phone number or e-mail address to the photofinisher to retrieve the photofinishing services. However, Kubota does disclose that the external storage medium (122) can be identified therefore there is an inherent external storage medium password or identifier (page 6, paragraphs 128-130).

Okada discloses a digital camera system including a digital camera capable of being collected for reuse. The camera (10) disclosed by Okada stores photographed image data (73a) and an identification code (73b) for identifying an individual camera (10). The system also includes a memory card (74) that stores a URL and a password (74a) for obtaining photographed data (page 6, paragraph 101). Okada further states that a user may give their email address to the selling store in order to receive the password and URL by email (page 6, paragraphs 110-11). Therefore, it would have been obvious for one skilled in the art to have been motivated to write an identifier unique to the photographer as disclosed by Okada in the memory disclosed by the combination of the Kubota and Nanba references and present the identifier in order to

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retrieve photofinishing services. Doing so would provide a means for effectively identifying a photographer and allowing a photofinisher to easily produce a print of an image and distribute it to the photographer.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 further in view of Okada et al. US 2001/0040625 and further in view of Maginess et al. US 4,870,257.

Re claim 22, the combination of the Kubota and Nanba references discloses all of the limitations of claim 1 above. However, the combination fails to disclose that the method further comprises the step of writing a phone number or e-mail address of the photographer on a photofinishing envelope and presenting the phone number or e-mail address to the photofinisher to retrieve the photofinishing services. However, Kubota does disclose that the external storage medium (122) can be identified therefore there is an inherent external storage medium password or identifier (page 6, paragraphs 128-130).

Okada discloses a digital camera system including a digital camera capable of being collected for reuse. The camera (10) disclosed by Okada stores photographed image data (73a) and an identification code (73b) for identifying an individual camera (10). The system also includes a memory card (74) that stores a URL and a password (74a) for obtaining photographed data (page 6, paragraph 101). Okada further states that a user may give their email address to the selling store in order to receive the

password and URL by email (page 6, paragraphs 110-11). Therefore, it would have been obvious for one skilled in the art to have been motivated to write an identifier unique to the photographer as disclosed by Okada in the memory disclosed by the combination of the Kubota and Nanba references and present the identifier in order to retrieve photofinishing services. Doing so would provide a means for effectively identifying a photographer and allowing a photofinisher to easily produce a print of an image and distribute it to the photographer. However, although the combination of the Kubota, Nanba and Okada references disclose all of the above limitations none of the references discloses wiring a phone number or e-mail address of the photographer on a photofinishing envelope.

Maginness discloses a photofinishing method in which a user provides their name and address on a photofinishing envelope containing image information to be produced as prints (col. 3 lines 38 – col. 4 line 27.) In light of the teachings of Maginness, it would have been obvious to one of ordinary skill in the art at the time of the invention to employ a photofinishing envelope to hold the memory device, in which the photofinishing envelope had the phone number or e-mail address of the photographer on it instead of on the memory device, with the method of the combination of Kubota, Nanba and Okada in which a phone number or e-mail address is used to retrieve the photofinishing order, in order to provide a way to transport the memory device without exposing the password to a possible unauthorized user, while still being able to associate the memory device with the intended user for retrieval of the photofinishing order.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota US 2003/0001957 in view of Nanba US 6,297,870 further in view of Takano US 2001/0041072 and further in view of Hunter US 7,139,095.

Re claim 29, the combination of the Kubota and Nanba references discloses all of the limitations of claim 1 above. However, neither reference states that the method further comprising the steps of the photofinisher producing at least one print and a CD of the digital images from the memory device and returning the at least one print and CD to the photographer, and indicating on the at least one print the filename of the corresponding image file recorded on the CD. However, Kubota does state that the images may be printed out by the photofinisher.

Nevertheless, Takano discloses producing and providing an index print to a digital image customer in which the image is assigned a number corresponding to the digital image (figure 2 indicator 76, figure 18 indicator 706; pages 5-6 paragraphs 83-84), as well as producing a CD on which the corresponding digital images are stored (figure 5, indicator 24 and 63; page 7, paragraph 101). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a print index and CD, with corresponding image labels/names as taught by Takano with the method as taught by Okada so that a customer may take the physical print index with them so that they do not have to immediately decide which prints to purchase upon submission of the memory device, and so that they are not required to use a computer or other device to

view potential images, as well as providing a logical method of using the CD to make later print selections by way of matching image numbering convention. However, neither Kubota, Nanba nor Takano disclose indicating on the at least one print the filename of the corresponding image file recorded on the CD.

Hunter discloses producing a print in which a unique identifier and image number are provide, the unique identifier and image number corresponding to that found in the digital memory (fig. 7; col. 4 lines 25-61.) It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the use of a unique identifier and an image number on a print containing an image that corresponds to a digital version of the image, with the method as taught by Kubota, Nanba and Takano, so that a user can quickly identify the image, via the identifier or number, for creating additional printouts.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly L. Jerabek whose telephone number is **(571) 272-7312**. The examiner can normally be reached on Monday - Friday (8:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on **(571) 272-7372**. The fax phone number for submitting all Official communications is **(571) 273-7300**. The fax phone number for submitting informal communications such as drafts, proposed amendments, etc., may be faxed directly to the Examiner at **(571) 273-7312**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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